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### **REMARKS**

Applicants have cancelled Claims 1-3, 7-10 and 15 without prejudice to, or disclaimer of, the subject matter contained therein. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application.

Applicants have amended Claims 4, 5, 6 and 14 to delete elements (a)-(b). Claims 4 and 5 are amended to delete the portion of the claim "wherein said isolated nucleic acid encodes a polypeptide that is more highly expressed in normal lung tissue compared to lung tumor." Claim 14 is amended to include "or a complement thereof" to amended elements (a)-(c), and the following text "wherein said isolated nucleic acid molecule is suitable for use as a PCR primer, or probe; and wherein said isolated nucleic acid is at least about 20 nucleotides in length." Claim 16 is amended to read "at least about 50 nucleotides in length." Claim 17 is amended to depend from Claim 4. New Claims 21-31 have been added.

Applicants submit that no new matter has been added by the amendments, and that support for the amendments can be found throughout the specification. Support for the amendments to Claim 14 can be found, for example, at paragraphs [0012], [0317], and [0327] of the specification. Support for the amendment to Claim 16 and new Claims 21-25 can be found, for example, at paragraph [0012]. Support for new Claims 26-31 can be found, for example, in the claims as originally filed, and paragraphs [0227] and [0317].

Applicants thank the Examiner for the review of the instant application, withdrawing the objection to the specification, and deleting the requested inventors. Applicants acknowledge the Examiner's partial withdrawal of the rejection of Claims 1-6, 8, 14 and 16-20 under 35 U.S.C. § 112, first paragraph, for lack of written description, and the withdrawal of the rejection of Claims 1-8, 11-20 under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejections of the presently pending claims are respectfully traversed. Claims 4-6, 11-14, and 16-31 are presented for examination.

#### **Priority**

Applicants acknowledge that the Examiner has granted the present application a priority date of August 24, 2000, the filing date of PCT/US00/23328.

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### **Rejection Under 35 U.S.C. §101 – Utility**

The PTO maintains its rejection of Claims 1-8, 11-14 and 16-20 under 35 U.S.C. § 101 as lacking utility for the reasons set forth on pages 3-9 of the previous Office Action. The PTO asserts that the data of Example 18 “showing a very small increase in DNA copy number – by about 2-fold - in normal lung tissue” are insufficient, because “there is no evidence regarding whether or not PRO1270 mRNA or polypeptide levels are also increased in this tissue.” Office Action at 4. According to the PTO, “one skilled in the art would not assume that a small increase in gene copy number would correlate with significantly increased mRNA or polypeptide levels.” Office Action at 5.

The PTO also argues that “[t]he PRO1270 gene has *not* been associated with tumor formation or the development of cancer... No mutation or translocation of PRO1270 has been associated with melanoma tissue.” Office Action at 7-8. “It is not known whether PRO1270 is underexpressed in other normal tissues or overexpressed in other cancers, and what the relative levels of expression are.” Office Action at 8. In addition, “[o]ne cannot determine from the data in the specification whether the observed ‘amplification’ of nucleic acid is due to increase in chromosomal copy number, or alternatively due to an increase in transcription rates.” Office Action at 8. The PTO concludes that in the absence of any of the above information, the disclosure is insufficient to meet the utility requirement.

Applicants respectfully disagree.

### **Utility – Legal Standard**

According to the Utility Examination Guidelines (“Utility Guidelines”), 66 Fed. Reg. 1092 (2001) an invention complies with the utility requirement of 35 U.S.C. § 101, if it has at least one asserted “specific, substantial, and credible utility” or a “well-established utility.”

Under the Utility Guidelines, a utility is “specific” when it is particular to the subject matter claimed. For example, it is generally not enough to state that a nucleic acid is useful as a diagnostic tool without also identifying the condition that is to be diagnosed.

The requirement of “substantial utility” defines a “real world” use, and derives from the Supreme Court’s holding in *Brenner v. Manson*, 383 U.S. 519, 534 (1966) stating that “The basic *quid pro quo* contemplated by the Constitution and the Congress for granting a patent monopoly

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is the benefit derived by the public from an invention with substantial utility.” In explaining the “substantial utility” standard, M.P.E.P. § 2107.01 cautions, however, that Office personnel must be careful not to interpret the phrase “immediate benefit to the public” or similar formulations used in certain court decisions to mean that products or services based on the claimed invention must be “currently available” to the public in order to satisfy the utility requirement. “Rather, *any reasonable use that an applicant has identified for the invention that can be viewed as providing a public benefit should be accepted as sufficient*, at least with regard to defining a ‘substantial’ utility.” (M.P.E.P. § 2107.01, emphasis added).

The mere consideration that further experimentation might be performed to more fully develop the claimed subject matter does not support a finding of lack of utility. M.P.E.P. § 2107.01 III cites *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995) in stating that “Usefulness in patent law ... necessarily includes the expectation of further research and development. The stage at which an invention in this field becomes useful is well before it is ready to be administered to humans.” Further, “[T]o violate § 101 the claimed device must be totally incapable of achieving a useful result” *Juicy Whip Inc. v. Orange Bang Inc.*, 51 USPQ2d 1700 (Fed. Cir. 1999), citing *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed.Cir.1992).

Indeed, the Guidelines for Examination of Applications for Compliance With the Utility Requirement, set forth in M.P.E.P. § 2107 II(B)(1) gives the following instruction to patent examiners: “If the applicant has asserted that the claimed invention is useful for any particular practical purpose ... and the assertion would be considered credible by a person of ordinary skill in the art, do not impose a rejection based on lack of utility.”

Finally, in assessing the credibility of the asserted utility, the M.P.E.P. states that “to overcome the presumption of truth that an assertion of utility by the applicant enjoys” the PTO must establish that it is “more likely than not that one of ordinary skill in the art would doubt (i.e., “question”) the truth of the statement of utility.” M.P.E.P. § 2107.02 III A. The M.P.E.P. cautions that:

Rejections under 35 U.S.C. 101 have been **rarely sustained** by federal courts. Generally speaking, **in these rare cases**, the 35 U.S.C. 101 rejection was sustained either because the **applicant ... asserted a utility that could only be true if it violated a scientific principle, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with**

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**contemporary knowledge in the art.** M.P.E.P. § 2107.02 III B. (underline emphasis in original, bold emphasis added); citing *In re Gazave*, 379 F.2d 973, 978, 154 USPQ 92, 96 (CCPA 1967).

*Utility need NOT be Proved to a Statistical Certainty – a Reasonable Correlation between the Evidence and the Asserted Utility is Sufficient*

An Applicant's assertion of utility creates a presumption of utility that will be sufficient to satisfy the utility requirement of 35 U.S.C. § 101, “unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope.” *In re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974). *See, also In re Jolles*, 628 F.2d 1322, 206 USPQ 885 (CCPA 1980); *In re Irons*, 340 F.2d 974, 144 USPQ 351 (1965); *In re Sichert*, 566 F.2d 1154, 1159, 196 USPQ 209, 212-13 (CCPA 1977). Compliance with 35 U.S.C. § 101 is a question of fact. *Raytheon v. Roper*, 724 F.2d 951, 956, 220 USPQ 592, 596 (Fed. Cir. 1983) cert. denied, 469 US 835 (1984). The evidentiary standard to be used throughout *ex parte* examination in setting forth a rejection is a preponderance of the evidence, or “more likely than not” standard. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). This is stated explicitly in the M.P.E.P.:

[T]he applicant does not have to provide evidence sufficient to establish that an asserted utility is true “beyond a reasonable doubt.” **Nor must the applicant provide evidence such that it establishes an asserted utility as a matter of statistical certainty.** Instead, evidence will be sufficient if, considered as a whole, it leads a person of ordinary skill in the art to conclude that the asserted utility is more likely than not true. M.P.E.P. at § 2107.02, part VII (2004) (underline emphasis in original, bold emphasis added, internal citations omitted).

The PTO has the initial burden to offer evidence “that one of ordinary skill in the art would reasonably doubt the asserted utility.” *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995). Only then does the burden shift to the Applicant to provide rebuttal evidence. *Id.* As stated in the M.P.E.P., such rebuttal evidence does not need to absolutely prove that the asserted utility is real. Rather, the evidence only needs to be reasonably indicative of the asserted utility.

In *Fujikawa v. Wattanasin*, 93 F.3d 1559, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996), the Court of Appeals for the Federal Circuit upheld a PTO decision that *in vitro* testing of a novel pharmaceutical compound was sufficient to establish practical utility, stating the following rule:

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[T]esting is often required to establish practical utility. But the test results **need not absolutely prove** that the compound is pharmacologically active. All that is required is that the tests be “*reasonably* indicative of the desired [pharmacological] response.” In other words, there must be a **sufficient correlation** between the tests and an asserted pharmacological activity so as to convince those skilled in the art, **to a reasonable probability**, that the novel compound will exhibit the asserted pharmacological behavior.” *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1564, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996) (internal citations omitted, bold emphasis added, italics in original).

While the *Fujikawa* case was in the context of utility for pharmaceutical compounds, the principals stated by the Court are applicable in the instant case where the asserted utility is for a therapeutic and diagnostic use – utility does not have to be established to an absolute certainty, rather, the evidence must convince a person of skill in the art “to a reasonable probability.” In addition, the evidence need not be direct, so long as there is a “sufficient correlation” between the tests performed and the asserted utility.

Thus, the legal standard for demonstrating utility is a relatively low hurdle. An Applicant need only provide evidence such that it is **more likely than not that a person of skill in the art would be convinced, to a reasonable probability, that the asserted utility is true.** The evidence need not be direct evidence, so long as there is a reasonable correlation between the evidence and the asserted utility. The Applicant **does not need to provide evidence such that it establishes an asserted utility as a matter of statistical certainty.**

Even assuming that the PTO has met its initial burden to offer evidence that one of ordinary skill in the art would reasonably doubt the truth of the asserted utility, Applicants assert that they have met their burden of providing rebuttal evidence such that it is more likely than not those skilled in the art, to a reasonable probability, would believe that the claimed invention is useful as a diagnostic tool for cancer.

### **Substantial Utility**

*The Data in Example 18 are Data Regarding Differential mRNA Levels, not Gene Amplification*

Applicants begin by clarifying that the data concerning the differential expression of the PRO1270 gene presented in Example 18 relate to gene expression, not gene amplification. The description of Example 18 makes clear that the results were obtained by quantitative PCR amplification of cDNA libraries. It is well known in the art that cDNA libraries are made from

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mRNA, and reflect the level of mRNA for a particular gene in the source tissue. Thus, Example 18 is reporting a measure of the *expression* of the PRO1270 gene, i.e. mRNA levels, not its *amplification*, i.e. the number of copies of PRO1270 in the genome.

Throughout the final Office Action, the PTO refers to Example 18 as “amplification data.” For example, the PTO states “[g]iven the small increase in DNA copy number of PRO1270...one skilled in the art would not assume that a small increase in gene copy number would correlate with significantly increased mRNA or polypeptide levels.” Office Action at 5 (emphasis added). Similarly, the PTO states that the specification provides “no evidence regarding whether or not PRO1270 mRNA or polypeptide levels are also increased.” Office Action at 4 (emphasis added). In rejecting the declaration of Chris Grimaldi, the PTO states that “it is important to note that the instant specification provides no information regarding increased protein, DNA or mRNA levels of PRO1270 in tumor samples as contrasted to normal tissue samples:....Only gene amplification data were presented.” Office Action at 7 (emphasis added).

Applicants submit that the PTO has misinterpreted the data presented in this application. Clearly, Example 18 reports data regarding differential mRNA levels, **not** gene amplification data.

The PTO relies on Pennica *et al.* to teach that “what is often seen is a *lack* of correlation between DNA amplification and increased peptide levels.” Office Action at 4 (emphasis in original). Whether or not gene amplification leads to increased gene expression is irrelevant to this particular application. Likewise, whether the differential mRNA expression of the PRO1270 gene reported in Example 18 is due to an increase or decrease in copy number, or alternatively due to an increase or decrease in transcription rates, is simply not relevant. Applicants have provided reliable evidence that the PRO1270 mRNA is differentially expressed in lung tumors. Whether this differential expression is due to changes in gene copy number, transcription rates, a combination of the two, or some other known or unknown cellular mechanism is simply not relevant to Applicants’ asserted utility.

#### Summary of Applicants’ Arguments and the PTO’s Response

In an attempt to clarify Applicants’ argument, Applicants offer a summary of their argument and the disputed issues involved.

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1. Applicants assert they have provided reliable evidence that mRNA for the PRO1270 polypeptide is expressed at least two-fold higher in normal lung compared to lung tumor, and therefore the claimed nucleic acids are useful as diagnostic tools. Applicants are not asserting that the claimed nucleic acids will necessarily provide a definitive diagnosis of cancer, but rather that they are useful, alone or in combination with other diagnostic tools to assist in the diagnosis of lung cancer.

2. Applicants submit that it is not necessary to know what role the PRO1270 gene plays in cancer to use its differential expression as a diagnostic tool.

3. It is not required to prove that the PRO1270 polypeptide is also differentially expressed in lung tumor to establish the utility of the claimed nucleic acids.

Applicants understand the PTO to be making several arguments in response to Applicants' asserted utility:

1. The PTO has challenged the reliability of the evidence reported in Example 18, and states that it provides no information regarding differential mRNA expression;

2. The PTO cites Pennica *et al.* to support its position that gene amplification is not necessarily correlated to gene expression;

3. The PTO cites Hu *et al.* and Haynes *et al.* to support its assertion that the literature cautions against drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue, and that mRNA levels are not predictive of protein levels;

4. The PTO concludes that based on the cited literature, one of skill in the art would not assume that the increase in gene amplification of PRO1270 would correlate with increased mRNA or polypeptide levels. Therefore, further research needs to be done to determine if the increase in PRO1270 DNA supports a role for the peptide in any tissue. (See final Office Action at 5).

As detailed below, Applicants submit that the PTO has failed to meet its initial burden to offer evidence "that one of ordinary skill in the art would reasonably doubt the asserted utility." *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995). First, the PTO has failed to offer any evidence to support its rejection of the data in Example 18 and the Declaration of Chris Grimaldi in support of these data. Second, as discussed above and can be seen from Applicants' summary of their argument, Applicants submit that any lack of correlation between

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gene amplification and gene expression is not at issue in this application and therefore the Pennica *et al.* reference is not relevant. Third, Applicants submit that given the well-established correlation between a change in the level of mRNA and a corresponding change in the levels of the encoded protein, the PRO1270 protein is likely differentially expressed in lung tumors. However, utility for the pending claims does not rely on whether the encoded polypeptide is differentially expressed, and as such whether or not increased levels of PRO1270 mRNA correlate with increased levels of PRO1270 protein is not presently an issue.

*Applicants have established that the Gene Encoding the PRO1270 Polypeptide is Differentially Expressed in Certain Cancers compared to Normal Tissue*

Applicants first address the PTO's argument that the evidence of differential expression of the gene encoding the PRO1270 polypeptide in lung tumors is insufficient. Applicants submit that the gene expression data provided in Example 18 of the present application are sufficient to establish that the PRO1270 gene is differentially expressed in lung tumors.

The gene expression data in the specification, Example 18, shows that the mRNA associated with protein PRO1270 was more highly expressed in normal lung than in lung tumor. Gene expression was analyzed using standard semi-quantitative PCR amplification reactions of cDNA libraries isolated from different human tumor and normal human tissue samples. Identification of the differential expression of the PRO1270 polypeptide-encoding gene in tumor tissue compared to the corresponding normal tissue renders the molecule useful as a diagnostic tool for the determination of the presence or absence of tumor. Applicants previously submitted as Exhibit 1 a first Declaration of J. Christopher Grimaldi, an expert in the field of cancer biology. This declaration explains the importance of the data in Example 18, and how differential gene and protein expression studies are used to differentiate between normal and tumor tissue (see Declaration, paragraph 7).

In paragraph 5 of his declaration, Mr. Grimaldi states that the gene expression studies reported in Example 18 of the instant application were made from pooled samples of normal and of tumor tissues. Mr. Grimaldi explains that:

The DNA libraries used in the gene expression studies were made from pooled samples of normal and of tumor tissues. *Data from pooled samples is more likely to be accurate than data obtained from a sample from a single individual.* That



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is, the detection of variations in gene expression is likely to represent a more generally relevant condition when pooled samples from normal tissues are compared with pooled samples from tumors in the same tissue type. (Paragraph 5) (emphasis added).

In paragraphs 6 and 7, Mr. Grimaldi explains that the semi-quantitative analysis employed to generate the data of Example 18 is sufficient to determine if a gene is over- or under-expressed in tumor cells compared to corresponding normal tissue. He states that any visually detectable difference seen between two samples is indicative of at least a two-fold difference in cDNA between the tumor tissue and the counterpart normal tissue. Thus, the results of Example 18 reflect at least a two-fold difference between normal and tumor samples. He also states that the results of the gene expression studies indicate that the genes of interest “can be used to differentiate tumor from normal,” thus establishing their reliability. He explains that, contrary to the PTO’s assertions, “The precise levels of gene expression are irrelevant; what matters is that there is a relative difference in expression between normal tissue and tumor tissue.” (Paragraph 7). Thus, since it is the relative level of expression between normal tissue and suspected cancerous tissue that is important, the precise level of expression in normal tissue is irrelevant. Likewise, there is no need for quantitative data to compare the level of expression in normal and tumor tissue. As Mr. Grimaldi states, “If a difference is detected, this indicates that the gene and its corresponding polypeptide and antibodies against the polypeptide are useful for diagnostic purposes, to screen samples to differentiate between normal and tumor.”

Applicants submit that the declaration of Mr. Grimaldi is based on personal knowledge of the relevant facts at issue. Mr. Grimaldi is an expert in the field and conducted or supervised the experiments at issue. Applicants remind the PTO that “[o]ffice personnel must accept an opinion from a qualified expert that is based upon relevant facts whose accuracy is not being questioned.” PTO Utility Examination Guidelines (2001) (emphasis added). In addition, declarations relating to issues of fact should not be summarily dismissed as “opinions” without an adequate explanation of how the declaration fails to rebut the Examiner’s position. *In re Alton* 76 F.3d 1168 (Fed. Cir. 1996).

The PTO has not supplied any reasons or evidence to question the accuracy of the facts upon which Mr. Grimaldi based his opinion. Mr. Grimaldi has personal knowledge of the relevant facts, has based his opinion on those facts, and the PTO has offered no reason or

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evidence to reject either the underlying facts or his opinion. Therefore, the PTO should accept Mr. Grimaldi's opinion with regard to his statement that "any visually detectable difference seen between two samples is indicative of at least a two-fold difference in cDNA between the tumor tissue and the counterpart normal tissue" and that the nucleic acids of interest "can be used to differentiate tumor from normal." Together, these statements establish that there is at least a two-fold difference in expression, and that the results are reliable enough that they can be used to distinguish tumor from normal tissue.

After summarizing the first Grimaldi declaration, the PTO states "[o]ne cannot determine from the data in the specification whether the observed 'amplification' of nucleic acid is due to increase in chromosomal copy number, or alternatively due to increase in transcription rates," and that the specification does not provide any information regarding "increased protein, DNA, or mRNA levels of PRO1270 in tumor samples as contrasted to normal tissue samples: Only gene amplification data were presented." Office Action at 7.

As an initial matter, Applicant's again point out that the data in Example 18 are gene expression data, not gene amplification data. The specification and the first Grimaldi Declaration make clear that Example 18 used semi-quantitative PCR of cDNA libraries. Therefore, one of skill in the art would know that Example 18 is a measure of mRNA levels, and reflects differential PRO1270 gene expression, not gene amplification. As discussed above, the PTO cites Pennica *et al.* for support of the argument that gene amplification does not necessarily lead to increased gene expression. This reference is irrelevant to the instant application which reports differential gene expression, not gene amplification. Therefore, the reference and the PTO's arguments regarding gene amplification do not support the PTO's challenge of the sufficiency of the Example 18 data, or the first Grimaldi Declaration.

The PTO also cites Hu *et al.* (J. Proteome Res., 2(4):405-12 (2003)) for support for its assertion the literature cautions researchers from drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue. The PTO states that Hu teaches that not all genes with increased expression in cancer have a known or published role in cancer.

In Hu, the researchers used an automated literature-mining tool to summarize and estimate the relative strengths of all human gene-disease relationships published on Medline.

They then generated a microarray expression dataset comparing breast cancer and normal breast tissue. Using their data-mining tool, they looked for a correlation between the strength of the literature association between the gene and breast cancer, and the magnitude of the difference in expression level. They report that for genes displaying a 5-fold change or less in tumors compared to normal, there was no evidence of a correlation between altered gene expression and a *known* role in the disease. See Hu at 411. However, among genes with a 10-fold or more change in expression level, there was a strong correlation between expression level and a *published* role in the disease. *Id.* at 412. Importantly, Hu reports that the observed correlation was only found among estrogen receptor-positive tumors, not less-prevalent ER-negative tumors. *Id.*

The general findings of Hu are not surprising – one would expect that genes with the greatest change in expression in a disease would be the first targets of research, and therefore have the strongest known relationship to the disease as measured by the number of publications reporting a connection with the disease. The correlation reported in Hu only indicates that the greater the change in expression level, the more likely it is that there is a *published* or *known* role for the gene in the disease, as found by their automated literature-mining software. Thus, Hu’s results merely reflect a bias in the literature toward studying the most prominent targets, and reflect nothing regarding the ability of a gene that is 2-fold or more differentially expressed in tumors to serve as a disease marker.

Hu acknowledges the shortcomings of this method in explaining the disparity in Hu’s findings for ER-negative versus ER-positive tumors: Hu attributes the “bias in the literature” toward the more prevalent ER-positive tumors as the explanation for the lack of any correlation between number of publications and gene expression levels in less-prevalent (and, therefore, less studied) ER-negative tumors. *Id.* Because of this intrinsic bias, Hu’s methodology is unlikely to ever note a correlation of a disease with less differentially-expressed genes and their corresponding proteins, regardless of whether or not an actual relationship between the disease and less differentially-expressed genes exists. Accordingly, Hu’s methodology yields results that provide little or no information regarding biological significance of genes with less than 5-fold expression change in disease. Nowhere in Hu does it say that a lack of correlation in their study

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means that genes with a less than five-fold change in the level of expression in cancer cannot serve as molecular markers of cancer.

Applicants submit that a lack of known role for PRO1207 in cancer does not prevent its use as a diagnostic tool for cancer. There is a difference between use of a gene for distinguishing between tumor and normal tissue on the one hand, and establishing a role for the gene in cancer on the other. Genes with lower levels of change in expression may or may not be the most important genes in causing the disease, but the genes can still show a consistent and measurable change in expression. While such genes may or may not be good targets for further research, they can nonetheless be used as diagnostic tools. Thus, Hu does not refute the Applicants' assertion that the PRO1270 gene can be used as a cancer diagnostic tool because it is differentially expressed in lung tumors.

In addition, whether the differential expression of the PRO1270 gene is due to an increase in chromosomal copy number or increased transcription rates is not relevant to whether the difference in expression can be used to distinguish tumor from normal tissue. Similarly, the fact that there is no known translocation or mutation of PRO1270 is irrelevant to whether its differential expression can be used to assist in diagnosis of cancer – one does not need to know why PRO1270 is differentially expressed, or what the consequence of the differential expression is, in order to exploit the differential expression to distinguish tumor from normal tissue.

The PTO has recognized that the utility of a nucleic acid does not depend on the function of the encoded gene product. The Utility Examination Guidelines published on January 5, 2001 state "In addition, the utility of a claimed DNA does not necessarily depend on the function of the encoded gene product. A claimed DNA may have a specific and substantial utility because, e.g. it hybridizes near a disease-associated gene or it has a gene regulating activity." (Federal Register, Volume 66, page 1095, Comment 14). While Applicants appreciate that actions taken in other applications are not binding on the PTO with respect to the present application, Applicants note that the PTO issues patents relating to nucleic acids which are useful for diagnosing particular conditions regardless of whether the nucleic acids are the causative agent for the condition. For example, polymorphisms which are indicative of a predisposition to a particular condition are patentable (*see, e.g.*, U.S. Patent No. 6,465,185, U.S. Patent No. 6,228,582, and U.S. Patent No. 6,162,604 submitted herewith as Exhibits 1-3), even though they

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may or may not cause the disease itself. Similarly, the present nucleic acids which are useful for determining whether an individual has cancer are useful regardless of whether or not they are the cause of the cancer.

The position of the PTO in this case is inconsistent with the analogous standard for therapeutic utility of a compound; that “the mere identification of a pharmacological activity of a compound that is relevant to an asserted pharmacological use provides an ‘immediate benefit to the public’ and thus satisfies the utility requirement.” M.P.E.P. § 2701.01 (emphasis in original). Here, the mere identification of altered expression in tumors is relevant to the diagnosis of tumors, and therefore provides an immediate benefit to the public.

In conclusion, Applicants submit that the evidence reported in Example 18, combined with the first Grimaldi Declaration, establish that there is at least a two-fold difference in PRO1270 cDNA between lung tumor tissue and normal lung tissue. Therefore, it follows that expression levels of the PRO1270 gene can be used to distinguish lung tumor tissue from normal lung tissue. The PTO has not offered any significant arguments or evidence to the contrary. Applicants have therefore established a utility for the claimed nucleic acids as diagnostic tools for cancer, particularly lung tumors.

*Applicants have established that the Accepted Understanding in the Art is that there is a Direct Correlation between mRNA Levels and the Level of Expression of the Encoded Protein*

Because the claims have been amended such that the claimed nucleic acids are not defined by the sequence of the polypeptide they encode, the question of whether there is a correlation between changes in gene expression and changes in protein expression is not presently at issue. However, Applicants submit that they have established for the record that it is well-established in the art that a change in the level of mRNA for a particular protein, generally leads to a corresponding change in the level of the encoded protein. Given Applicants’ evidence of differential expression of the mRNA for the PRO1270 polypeptide in lung tumor, it is more likely than not that the PRO1270 is also differentially expressed.

The PTO cites Haynes *et al.* (Electrophoresis, 19(11):1862-71 (1998)) as support for the assertion that “polypeptide levels cannot be accurately predicted from mRNA levels, and that according to their results, the ratio varies from zero to 50-fold.” Office Action at 5. Because the

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claims have been amended such that the claimed nucleic acids are not defined by the sequence of the polypeptide they encode, the question of whether there is a correlation between changes in gene expression and changes in protein expression is not presently at issue. Thus, the Haynes reference is not relevant. However, even if this issue were important for the utility of the claimed nucleic acids, Haynes does not support the PTO's position.

Haynes studied whether there is a correlation between the level of mRNA expression and the level of protein expression for 80 selected genes from yeast. The genes were selected because they constituted a relatively homogeneous group with respect to predicted half-life and expression level of the protein products. See Haynes at 1863. Haynes did not examine whether a change in transcript level for a particular gene led to a change in the level of expression of the corresponding protein. Instead, Haynes determined whether the steady-state transcript level correlated with the steady-state level of the corresponding protein based on an analysis of 80 different genes.

Haynes reported to have "found a general trend but no strong correlation between protein and transcript levels." *Id.* However, a cursory inspection of Fig. 1 shows a clear correlation between the mRNA levels and protein levels measured. This correlation is confirmed by an inspection of the full-length research paper from which the data in Fig. 1 were derived, presented herein as Exhibit 4 (Gygi *et al.*, Molecular and Cellular Biology, Mar. 1999, 1720-1730). Gygi states that "there was a general trend of increased protein levels resulting from increased mRNA levels," with a correlation coefficient of 0.935, indicating a strong correlation. Gygi at 1726. Moreover, Gygi also states that the correlation is especially strong for highly expressed mRNAs. *Id.* Thus, it is not clear that Haynes even supports the Examiner's position, as Haynes did report a general trend, and Gygi reports a strong correlation between increasing mRNA levels and increasing protein levels.

The PTO focuses on the portion of Haynes where the authors reported that for some of the studied genes with equivalent mRNA levels, there were differences in corresponding protein expression, including some that varied by more than 50-fold. Similarly, Haynes reports that different proteins with similar expression levels were maintained by transcript levels that varied by as much as 40-fold. *Id.* Thus, Haynes showed that for one type of yeast, similar mRNA levels for *different* genes did not universally result in equivalent protein levels for the *different*

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gene products, and similar protein levels for *different* gene products did not universally result from equivalent mRNA levels for the *different* genes. These results are expected, since there are many factors that determine translation efficiency for a given transcript, or the half-life of the encoded protein. Not surprisingly, based on these results, Haynes concluded that protein levels cannot always be accurately predicted from the level of the corresponding mRNA transcript *when looking at the level of transcripts across different genes*.

Importantly, Haynes did not say that for a single gene, the level of mRNA transcript is not positively correlated with the level of protein expression. Applicants have asserted that increasing or decreasing the level of mRNA for the same gene leads to an increase or decrease for the corresponding protein. Haynes did not study this issue and says absolutely nothing about it. Therefore, Haynes is not inconsistent with or contradictory to the utility of the instant claims, and offers no support for the PTO's position.

And even if Haynes supported the PTO's argument, which it does not, one contrary example does not establish that one of skill in the art would find it is more likely than not there is no general correlation between changes in mRNA level and changes in protein level for an individual gene. In fact, the working hypothesis among those skilled in the art, as illustrated by the evidence presented by Applicants, is that there is a positive correlation between changes in mRNA levels and changes in protein levels for a particular gene.

In support of the assertion that changes in mRNA are positively correlated to changes in protein levels, Applicants previously submitted a copy of a second Declaration by J. Christopher Grimaldi, an expert in the field of cancer biology (previously submitted as Exhibit 2). As stated in paragraph 5 of the declaration, "Those who work in this field are well aware that in the vast majority of cases, when a gene is over-expressed...the gene product or polypeptide will also be over-expressed.... This same principal applies to gene under-expression." Further, "the detection of increased mRNA expression is expected to result in increased polypeptide expression, and the detection of decreased mRNA expression is expected to result in decreased polypeptide expression. The detection of increased or decreased polypeptide expression can be used for cancer diagnosis and treatment." The references cited in the declaration and submitted herewith support this statement.

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Applicants also previously submitted a copy of the declaration of Paul Polakis, Ph.D. (previously submitted as Exhibit 3), an expert in the field of cancer biology. As stated in paragraph 6 of his declaration:

Based on my own experience accumulated in more than 20 years of research, including the data discussed in paragraphs 4 and 5 above [showing a positive correlation between mRNA levels and encoded protein levels in the vast majority of cases] and my knowledge of the relevant scientific literature, it is my considered scientific opinion that for human genes, an increased level of mRNA in a tumor cell relative to a normal cell typically correlates to a similar increase in abundance of the encoded protein in the tumor cell relative to the normal cell. In fact, *it remains a central dogma in molecular biology that increased mRNA levels are predictive of corresponding increased levels of the encoded protein.* (Emphasis added).

Dr. Polakis acknowledges that there are published cases where such a correlation does not exist, but states that it is his opinion, based on over 20 years of scientific research, that “such reports are exceptions to the commonly understood general rule that increased mRNA levels are predictive of corresponding increased levels of the encoded protein.” (Polakis Declaration, paragraph 6).

The statements of Grimaldi and Polakis are supported by the teachings in Molecular Biology of the Cell, a leading textbook in the field (Bruce Alberts, *et al.*, Molecular Biology of the Cell (3<sup>rd</sup> ed. 1994) (submitted herewith as Exhibit 5) and (4<sup>th</sup> ed. 2002) (submitted herewith as Exhibit 6)). Figure 9-2 of Exhibit 6 shows the steps at which eukaryotic gene expression can be controlled. The first step depicted is transcriptional control. Exhibit 5 provides that “[f]or most genes transcriptional controls are paramount. This makes sense because, of all the possible control points illustrated in Figure 9-2, only transcriptional control ensures that no superfluous intermediates are synthesized.” Exhibit 5 at 403 (emphasis added). In addition, the text states that “Although controls on the initiation of gene transcription are the predominant form of regulation for most genes, other controls can act later in the pathway from RNA to protein to modulate the amount of gene product that is made.” Exhibit 5 at 453 (emphasis added). Thus, as established in Exhibit 5, the predominant mechanism for regulating the amount of protein produced is by regulating transcription initiation.

In Exhibit 6, Figure 6-3 on page 302 illustrates the basic principle that there is a correlation between increased gene expression and increased protein expression. The



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accompanying text states that “a cell can change (or regulate) the expression of each of its genes according to the needs of the moment – *most obviously by controlling the production of its mRNA.*” Exhibit 6 at 302 (emphasis added). Similarly, Figure 6-90 on page 364 of Exhibit 6 illustrates the path from gene to protein. The accompanying text states that while potentially each step can be regulated by the cell, “the initiation of transcription is the most common point for a cell to regulate the expression of each of its genes.” Exhibit 6 at 364 (emphasis added). This point is repeated on page 379, where the authors state that of all the possible points for regulating protein expression, “[f]or most genes transcriptional controls are paramount.” Exhibit 6 at 379 (emphasis added).

Further support for Applicants’ position can be found in the textbook, *Genes VI*, (Benjamin Lewin, *Genes VI* (1997)) (submitted herewith as Exhibit 7) which states “having acknowledged that control of gene expression can occur at multiple stages, and that production of RNA cannot inevitably be equated with production of protein, it is clear that the overwhelming majority of regulatory events occur at the initiation of transcription.” *Genes VI* at 847-848 (emphasis added).

Additional support is also found in Zhigang *et al.*, *World Journal of Surgical Oncology* 2:13, 2004, submitted herewith as Exhibit 8. Zhigang studied the expression of prostate stem cell antigen (PSCA) protein and mRNA to validate it as a potential molecular target for diagnosis and treatment of human prostate cancer. The data showed “a high degree of correlation between PSCA protein and mRNA expression” Exhibit 8 at 4. Of the samples tested, 81 out of 87 showed a high degree of correlation between mRNA expression and protein expression. The authors conclude that “it is demonstrated that PSCA protein and mRNA overexpressed in human prostate cancer, and that the increased protein level of PSCA was resulted from the upregulated transcription of its mRNA.” Exhibit 8 at 6. Even though the correlation between mRNA expression and protein expression occurred in 93% of the samples tested, not 100%, the authors state that “PSCA may be a promising molecular marker for the clinical prognosis of human Pca and a valuable target for diagnosis and therapy of this tumor.” Exhibit 8 at 7.

Further, Meric *et al.*, *Molecular Cancer Therapeutics*, vol. 1, 971-979 (2002), submitted herewith as Exhibit 9, states the following:

The **fundamental principle** of molecular therapeutics in cancer is to exploit the differences in gene expression between cancer cells and normal cells...[M]ost

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efforts have concentrated on identifying differences in gene expression at the level of mRNA, which can be attributable to either DNA amplification or to differences in transcription. Meric *et al.* at 971 (emphasis added).

Those of skill in the art would not be focusing on differences in gene expression between cancer cells and normal cells if there were no correlation between gene expression and protein expression.

Together, the declarations of Grimaldi and Polakis, the accompanying references, and the excerpts and references provided above all establish that the accepted understanding in the art is that there is a reasonable correlation between changes in gene expression and the level of the encoded protein.

In response to the second Grimaldi Declaration and the Polakis Declaration, the PTO states that "it is important to note that the instant specification provides no information regarding decreased mRNA levels of PRO1270.... Only gene amplification data were presented. Therefore, the declaration is insufficient to overcome the rejection of claims 1-14 and 16-20... since it is limited to a discussion of data regarding the correlation of mRNA levels and polypeptide levels." Office Action at 8-9.

Applicants again reiterate that Example 18 is information regarding differential mRNA levels of PRO1270. Thus, the PTO's rejection of the second Grimaldi Declaration and Polakis Declaration because they discuss the correlation of mRNA levels and polypeptide levels is misplaced. Accordingly, Applicants submit that they have offered sufficient evidence to establish that it is more likely than not that one of skill in the art would believe that because the PRO1270 mRNA is more highly expressed in normal lung compared to lung tumor, the PRO1270 polypeptide will also be more highly expressed in normal lung compared to lung tumor.

*The References cited by the PTO are Not Sufficient to satisfy the PTO's Initial Burden of Offering Evidence "that one of ordinary skill in the art would reasonably doubt the asserted utility"*

As stated above, an Applicant's assertion of utility creates a presumption of utility that will be sufficient to satisfy the utility requirement of 35 U.S.C. § 101, "unless there is a reason for one skilled in the art to question the objective truth of the statement of utility or its scope." *In*

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*re Langer*, 503 F.2d 1380, 1391, 183 USPQ 288, 297 (CCPA 1974). The evidentiary standard to be used throughout *ex parte* examination in setting forth a rejection is a preponderance of the evidence, or “more likely than not” standard. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). This is stated explicitly in the M.P.E.P.:

[T]he applicant does not have to provide evidence sufficient to establish that an asserted utility is true “beyond a reasonable doubt.” **Nor must the applicant provide evidence such that it establishes an asserted utility as a matter of statistical certainty.** Instead, evidence will be sufficient if, considered as a whole, it leads a person of ordinary skill in the art to conclude that the asserted utility is more likely than not true. M.P.E.P. at § 2107.02, part VII (2004) (underline emphasis in original, bold emphasis added, internal citations omitted).

The PTO has the initial burden to offer evidence “that one of ordinary skill in the art would reasonably doubt the asserted utility.” *In re Brana*, 51 F.3d 1560, 1566, 34 U.S.P.Q.2d 1436 (Fed. Cir. 1995). Only then does the burden shift to the Applicant to provide rebuttal evidence. *Id.* As stated in the M.P.E.P., such rebuttal evidence does not need to absolutely prove that the asserted utility is real. Rather, the evidence only needs to be reasonably indicative of the asserted utility.

Applicants remind the PTO that the M.P.E.P. cautions that rejections for lack of utility are rarely sustained by federal courts, and that generally speaking, a utility rejection is only sustained where the applicant asserted a utility “that could only be true if it violated a scientific principal, such as the second law of thermodynamics, or a law of nature, or was wholly inconsistent with contemporary knowledge in the art.” M.P.E.P. § 2107.02 III B. Applicants asserted utility, that the claimed nucleic acids differentially expressed in lung tumor are useful as tools in the diagnosis of lung tumor, is squarely within the teachings of leading textbooks and is supported by the declarations of skilled experts in the field.

There is nothing in the cited references which cast any doubt on the Applicants’ asserted utility. As stated above, the Pennica *et al.* reference is not relevant because Example 18 reports gene expression data, not gene amplification data. Similarly, Haynes *et al.* and Hu *et al.* are also not sufficient to satisfy the PTO’s burden of offering evidence that a person of skill in the art would have a reasonable doubt that a gene differentially expressed in certain tumors can be used as a diagnostic tool since neither reference addresses this issue. Given the lack of support for the PTO’s position, and the supporting evidence provided by the Applicants for their position, one of

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skill in the art would be more likely than not to believe that the claimed nucleic acids can be used as diagnostic tools for cancer, particularly lung tumors.

### **Specific Utility**

#### *The Asserted Substantial Utilities are Specific to the Claimed Nucleic Acids*

Applicants next address the PTO's assertion that the asserted utilities are not specific to the claimed nucleic acids related to PRO1270. Applicants respectfully disagree.

Specific Utility is defined as utility which is "specific to the subject matter claimed," in contrast to "a general utility that would be applicable to the broad class of the invention." M.P.E.P. § 2107.01 I. Applicants submit that the evidence of differential expression of the PRO1270 gene in certain types of tumor cells, along with the declarations and references discussed above, provide a specific utility for the claimed nucleic acids.

As discussed above, there are significant data which show that the gene for the PRO1270 polypeptide is expressed at least two-fold higher in normal lung tissue compared to lung tumor tissue. These data are strong evidence that the PRO1270 gene is associated with lung tumors. Thus, contrary to the assertions of the PTO, Applicants submit that they have provided evidence associating the PRO1270 gene with a specific disease. The asserted utility as a diagnostic tool for cancer, particularly lung tumor, is a specific utility – it is not a general utility that would apply to the broad class of nucleic acids.

### **Conclusion**

The PTO has asserted the following arguments to support its conclusion that based on the cited literature, one of skill in the art would not assume that the increase in gene amplification of PRO1270 would correlate with increased mRNA or polypeptide levels: (1) the PTO has challenged the reliability of the evidence reported in Example 18; (2) the PTO cites Pennica *et al.* to support its position that gene amplification is not necessarily correlated to gene expression; and (3) the PTO cites Hu *et al.* and Haynes *et al.* to support its assertion that the literature cautions against drawing conclusions based on small changes in transcript expression levels between normal and cancerous tissue, and that mRNA levels are not predictive of protein levels. The PTO states that further research needs to be done to determine if the increase or decrease in

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PRO1270 DNA supports a role for the peptide in cancerous tissue. Applicants have addressed each of these arguments in turn.

First, the Applicants provided a first Declaration of Chris Grimaldi stating that the gene expression data in Example 18 are real and significant. This declaration also indicates that given the relative difference of at least two-fold in expression levels, the disclosed nucleic acids have utility as cancer diagnostic tools. The PTO has not offered any substantial reason or evidence to question the data in Example 18, or the first Grimaldi Declaration. Therefore, Applicants have established a basis for the use of the claimed nucleic acids as diagnostic tools, particularly for lung tumor. Second, Applicants have demonstrated that it is not necessary to know the cause or consequence of the differential expression of PRO1270 nucleic acids in certain tumors in order to use them as diagnostic tools for cancer. Third, Applicants state that whether the encoded polypeptide is also differentially expressed in certain tumors is currently not at issue in this application.

Applicants have shown that the Pennica *et al.* reference is irrelevant to the utility of the claimed nucleic acids. Applicants have also shown that the Hu *et al.* and Haynes *et al.* references are not contrary to Applicants' asserted utility. Taken together, these references do not satisfy the PTO's burden of offering evidence to prove that one of skill in the art would reasonably doubt the asserted utility.

Finally, the PTO asserts that there is no asserted specific utility. Applicants have pointed out that the substantial utilities described above are specific to the claimed nucleic acid because the PRO1270 gene and polypeptide are differentially expressed in lung tumors compared to the corresponding normal lung tissue. This is not a general utility that would apply to the broad class of nucleic acids.

Given the totality of the evidence provided, Applicants submit that they have established a substantial, specific, and credible utility for the claimed nucleic acids as a diagnostic tool. According to the PTO Utility Examination Guidelines (2001), irrefutable proof of a claimed utility is not required. Rather, a specific, substantial, and credible utility requires only a "reasonable" confirmation of a real world context of use. Applicants remind the PTO that:

A small degree of utility is sufficient . . . The claimed invention must only be capable of performing some beneficial function . . . An invention does not lack utility merely because the particular embodiment disclosed in the patent lacks

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perfection or performs crudely . . . A commercially successful product is not required . . . Nor is it essential that the invention accomplish all its intended functions . . . or operate under all conditions . . . partial success being sufficient to demonstrate patentable utility . . . In short, **the defense of non-utility cannot be sustained without proof of total incapacity**. If an invention is only partially successful in achieving a useful result, a rejection of the claimed invention as a whole based on a lack of utility is not appropriate. M.P.E.P. at 2107.01 (underline emphasis in original, bold emphasis added, citations omitted).

Applicants submit that they have established that it is more likely than not that one of skill in the art would reasonably accept the utility for the claimed nucleic acids as diagnostic tools as set forth in the specification. In view of the above, Applicants respectfully request that the PTO reconsider and withdraw the utility rejection under 35 U.S.C. §101.

**Rejections under 35 U.S.C. § 112, first paragraph – Enablement**

The PTO also rejects Claims 1-8, 11-14 and 16-20 under 35 U.S.C. § 112, first paragraph. Specifically, the PTO asserts that because the claimed invention is not supported by either a specific or substantial asserted utility or a well-established utility, one skilled in the art would not know how to use the claimed invention.

Applicants submit that in the discussion of the 35 U.S.C. § 101 rejection above, Applicants have established a substantial, specific, and credible utility for the claimed nucleic acids. To the extent that the enablement rejection is based on a lack of utility, Applicants respectfully request that the PTO reconsider and withdraw the enablement rejection under 35 U.S.C. §112.

**Rejection under 35 U.S.C. §112, first paragraph – Written Description**

The rejection of Claims 1-6, 8, 14 and 16-20 under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement is maintained for the reasons set forth in the previous Office Action. Briefly, the PTO asserts the “Applicants were not in possession of all or a significant number of polypeptides that have 80-99% homology to SEQ ID NO:88, while retaining the function of SEQ ID NO:88.” Office Action at 10.

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*The Legal Standard for Written Description*

The well-established test for sufficiency of support under the written description requirement of 35 U.S.C. §112, first paragraph is whether the disclosure “reasonably conveys to artisan that the inventor had possession at that time of the later claimed subject matter.” *In re Kaslow*, 707 F.2d 1366, 1375, 2121 USPQ 1089, 1096 (Fed. Cir. 1983); *see also Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116 (Fed. Cir. 1991). The adequacy of written description support is a factual issue and is to be determined on a case-by-case basis. *See e.g., Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116 (Fed. Cir. 1991). The factual determination in a written description analysis depends on the nature of the invention and the amount of knowledge imparted to those skilled in the art by the disclosure. *Union Oil v. Atlantic Richfield Co.*, 208 F.3d 989, 996 (Fed. Cir. 2000).

*The Current Invention is Adequately Described*

As noted above, whether the Applicants were in possession of the invention as of the effective filing date of an application is a factual determination, reached by the consideration of a number of factors, including the level of knowledge and skill in the art, and the teaching provided by the specification. The inventor is not required to describe every single detail of his/her invention. An Applicant’s disclosure obligation varies according to the art to which the invention pertains. The present invention pertains to the field of recombinant DNA/protein technology. It is well-established that the level of skill in this field is very high since a representative person of skill is generally a Ph.D. scientist with several years of experience. Accordingly, the teaching imparted in the specification must be evaluated through the eyes of a highly skilled artisan as of the date the invention was made.

The subject matter of the pending claims concerns nucleic acids having 95% or 99% sequence identity to the nucleic acid sequence of SEQ ID NO:87, the full-length coding sequence of the nucleic acid sequence of SEQ ID NO:87, or the full-length coding sequence of the cDNA deposited under ATCC accession number 203159, with the functional recitation as amended: “wherein said isolated nucleic acid is more highly expressed in normal lung compared to lung tumor” or “wherein said isolated nucleic acid hybridizes to the complement of a nucleic acid of SEQ ID NO:87” under the specified conditions. Other claimed nucleic acids are those which hybridize to the nucleic acid sequence of SEQ ID NO:87, the full-length coding sequence of the

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nucleic acid sequence of SEQ ID NO:87, the full-length coding sequence of the cDNA deposited under ATCC accession number 203159, or the complements thereof, under the specified stringent conditions. We turn first to the claims which recite specific high stringency hybridization conditions.

In *Enzo Biochem v. Gen-Probe Inc.*, 323 F.3d 956 (Fed. Cir. 2002), the Court held that functional descriptions of genetic material may satisfy the written description requirement. In so holding, the Court gave judicial notice to the USPTO's Manual of Patent Examining Procedure, which provides that the written description requirement may be satisfied when the disclosure provides sufficiently detailed identifying characteristics, such as "complete or partial structure, other physical and/or chemical properties, *functional characteristics when coupled with a known or disclosed correlation between function and structure*, or some combination of such characteristics." *Id.* at 964, quoting 66 Fed. Reg. at 1106 (emphasis in original). In *Enzo*, the Court found describing nucleic acids based on their ability to hybridize to another nucleic acid sequence which was adequately described may be an adequate description of the nucleic acid. This is because the hybridization function of a nucleic acid is dependent on the sequences of the nucleic acid – a disclosed function which is coupled with a known correlation between function and structure. The Court favorably discussed the PTO's example wherein "genus claims to nucleic acids based on their hybridization properties...may be adequately described if they hybridize under highly stringent conditions to known sequences because such conditions dictate that all species within the genus will be structurally similar." *Id.* at 967 (citing *Application of [Written Description] Guidelines*, Example 9) (emphasis added).

Applicants submit that the stringent hybridization conditions specified in the pending claims, alone or in combination with the recited percent sequence identity, result in all species within the genus being structurally similar. As the *Enzo* Court noted, Examples 9 and 10 of the Application of Written Description Guidelines (hereinafter "Guidelines") make clear that specifying hybridization under highly stringent conditions yields "structurally similar DNAs." Guidelines, Example 9 at page 36. The analysis of a genus claim in Example 10 of the Guidelines states:

[T]urning to the genus analysis, the art indicates that *there is no substantial variation within the [claimed] genus because of the stringency of hybridization conditions which yields structurally similar molecules.* The single disclosed



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species is representative of the genus because reduction to practice of this species, considered along with the defined hybridization conditions and the level of skill and knowledge in the art, are sufficient to allow the skilled artisan to recognize that applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus. Guidelines, Example 10 at page 39 (emphasis added).

Given the level of skill in the art, specifying highly stringent conditions leads to “no substantial variation within the [claimed] genus,” and therefore a skilled artisan would recognize that the Applicants were in possession of the necessary common attributes or features of the genus. The common element or attribute of the claimed genus is that species of the genus are structurally related to SEQ ID NO:87, such that they hybridize to SEQ ID NO:87 or the related sequences under the specified high stringency conditions recited in the claims.

The present situation is not analogous to *Fiddes v. Baird*, 30 U.S.P.Q. 2d 1481, cited by the PTO in the first Office Action. Unlike *Fiddes*, where arguably the structure of other mammalian sequences could not be conceived based on a single species of the genus, here the skill in the art is such that the sequence of nucleic acids which hybridize to SEQ ID NO:87 under the conditions specified can be conceived. Here, the claimed genus is defined by its structure – members of the genus hybridize under the specified conditions to the specified sequences, each of which are adequately described in the specification.

Applicants submit that the pending claims relating to nucleic acids having 95% or 99% sequence identity to the nucleic acids related to SEQ ID NO:87 with the functional recitation “wherein said isolated nucleic acid is more highly expressed in normal lung compared to lung tumor” are also adequately described. In Example 14 of the written description training materials, the written description requirement was found to be satisfied for claims relating to polypeptides having 95% homology to a particular sequence and possessing a particular catalytic activity, even though the applicant had not made any variants. Similarly, the pending claims also have very high sequence homology to the disclosed sequences and must share the same expression pattern in lung tumors. In Example 14, the procedures for making variants were known in the art and the disclosure taught how to test for the claimed catalytic activity. Similarly, in the instant application, it is well known in the art how to make nucleic acids which have at least 95% sequence identity to the disclosed sequences, and the specification discloses how to test to determine if the sequence is differentially expressed in lung tumors. Like Example

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14, the genus of nucleic acids that have at least 95% or 99% sequence identity to the disclosed sequences will not have substantial variation since all of the variants must have the same expression in certain tumors.

Furthermore, while Applicants appreciate that actions taken by the PTO in other applications are not binding with respect to the examination of the present application, Applicants note that the PTO has issued many patents containing claims to variant nucleic acids or variant proteins where the applicants did not actually make such nucleic acids or proteins. Representative patents include U.S. Patent No. 6,737,522, U.S. Patent No. 6,395,306, U.S. Patent No. 6,025,156, U.S. Patent No. 6,645,499, U.S. Patent No. 6,498,235, and U.S. Patent No. 6,730,502, which are attached hereto as Exhibits 10-15.

In conclusion, Applicants submit that they have satisfied the written description requirement for the pending claims based on the actual reduction to practice of SEQ ID NO:87, by specifying the high stringency conditions under which hybridization occurs, and by describing the gene expression assay, all of which result in a lack of substantial variability in the species falling within the scope of the instant claims. Applicants submit that this disclosure would allow one of skill in the art to "recognize that the applicant was in possession of the necessary common attributes or features of the elements possessed by the members of the genus." Hence, Applicants respectfully request that the PTO reconsider and withdraw the written description rejection under 35 U.S.C. §112.

### **CONCLUSION**

In view of the above, Applicants respectfully maintain that claims are patentable and request that they be passed to issue. Applicants invite the Examiner to call the undersigned if any remaining issues may be resolved by telephone.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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